

# BEST AVAILABLE COPY

Serial No. 09/783,241

## REMARKS

### I. Introduction

In response to the Office Action dated October 19, 2005, the claims have not been amended. Claims 40-66 remain in the application. Re-examination and re-consideration of the application is requested.

### II. Prior Art Rejections

In paragraphs (2)-(3) of the Office Action, claims 40-43, 48-52, 57-61, and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano et al., U.S. Publication No. 2002/0055847 (Nakano) in view of Hunter et al., U.S. Publication No. 2002/0056118 A1 (Hunter). In paragraph (4) of the Office Action, claims 46, 47, 55, 56, 64, and 65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49, and 58, and further in view of Hayward et al., U.S. Publication No. 2003/0023703 (Hayward). In paragraph (5) of the Office Action, claims 44, 45, 53, 54, 62, and 63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano and Hunter as applied to claims 40, 49, and 58 and further in view of Yamamoto et al., U.S. Patent No. 6,166,778 (Yamamoto).

Specifically, the independent claims were rejected as follows:

As to claim 40, Nakano discloses a method for receiving subscriber information (Fig. 6) comprising:

- (a) receiving, in a set top box (10, paragraph 27), broadcast signals (paragraph 22, lines 1-7) through a tuner of the set top box (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and
- (b) enabling a presentation device (television 12) connected to the set top box to display the broadcast signals (paragraph 22, lines 1-7);
- (c) automatically connecting (the set top makes a connection when the card is entered; paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (wherein connection take place upon entry of the card; paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information form the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analagous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

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It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 49, Nakano discloses a system for receiving information (Fig. 6) comprising:  
 a set top box is configured to:  
 receive broadcast signals (paragraph 22, lines 1-7) through a tuner (wherein a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7); and  
 enable a presentation device (television 12) connected to the set top box (Fig. 1) to display the broadcast signals (paragraph 22, lines 1-7);  
 automatically connect (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, lines 1-3), wherein the communication module is different than the tuner (Fig. 1; paragraph 22).

While Nakano discloses receiving information from the Internet (for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

As to claim 58, Nakano discloses an article of manufacture for receiving information (Fig. 6) comprising:

means for a set top box (Fig. 1; 10) connectable to a presentation device (Fig. 1; 12) to receive broadcast signals (paragraph 22; lines 1-7) through a tuner (a tuner is inherently present to tune to a broadcast channel; paragraph 22, lines 4-7);  
 means for the set top box (10) to enable the presentation device (television, 12) to display the broadcast signals (paragraph 22, lines 1-7);  
 means (a modem; paragraph 26, lines 1-9) for the set top box to automatically obtain a connection (paragraph 34, lines 1-3) to the Internet (Fig. 5; paragraph 26, lines 1-8) using a communication module (a modem; paragraph 26, lines 5-8) of the set top box (paragraph 26, lines 5-8) without the user requesting the connection (paragraph 33, lines 6-12 and paragraph 34, line 1-3), wherein the communication module is different the tuner (Fig. 1; paragraph 22).

While Nakano discloses means for receiving information from the Internet (a modem for home shopping; paragraph 31, 36 and 37), he fails to specifically disclose receiving a subscriber renewal notice over the connection to the Internet.

In an analogous art, Hunter discloses a video distribution system (Fig. 4; paragraph 12) wherein a user will receive broadcast video for display on a television (paragraphs 65 and 70) and will automatically connect to the Internet through a modem (87, paragraph 51, lines 16-18 and 31-34 and paragraph 67) to receive monthly subscriber renewal notices (monthly renewed security codes to ensure a site is authorized to view the movie; paragraphs 79, 82 and 83) for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display videos (paragraph 79).

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It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Nakano's system to include receiving a subscriber renewal notice over the connection to the Internet, as taught by Hunter, for the typical benefit of ensuring that only authorized subscribers who are current on their payments may receive and display the received content.

Applicants traverse the above rejections for one or more of the following reasons:

- (1) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest a subscriber renewal notice; and
- (2) Nakano, Hunter, Hayward, and Yamamoto do not teach, disclose or suggest receiving a subscriber renewal notice over a connection to the Internet.

Independent claims 40, 49, and 58 are generally directed to the transmission and receipt of subscriber renewal notices through a connection to the Internet (i.e. via an ISP) rather than receiving such notices via satellite broadcast transmission. Sending renewal notices over an ISP connection saves satellite bandwidth that may be made available for other broadcast information. In addition, Applicants note that the dependent claims provide further limitations. For example, claims 42, 51, and 60 specify that the subscriber renewal notice comprises service provider facility data that is used by the set top box on a monthly basis.

The cited references do not teach nor suggest these various elements of Applicants' independent claims. In rejecting the claim elements relating to receiving subscriber renewal notices over the Internet, the Office Action relies on Hunter paragraph 79, 82, and 83. Paragraph 82 provides that a key for each 32-bit code movie is delivered to each customer household by phone/modem on a monthly basis. The paragraph further states that the keys are only provided when the customer household is current in payments and otherwise in good standing. As can be seen from this text, the keys are keys for a particular movie. Such a key is not similar nor suggested by the claimed "subscriber renewal notice". The plain language of the terms subscriber renewal notice indicate that it is a renewal notice for a subscriber and is not a key for a particular movie that is delivered on a monthly basis. Such a movie based key is not a subscriber renewal notice.

Paragraph 83 further describes that a movie will playback at a specific user station only when three code keys (including movie code key C) are present. Thus, rather than providing a renewal notice for a particular subscriber over a connection to the Internet as claimed, Hunter describes the delivery of a key for a particular movie over a phone/modem on a monthly basis. Such a teaching is sufficiently distinct and does not render obvious the claimed invention.

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In addition, Applicants note that the dependent claims provide further distinct advantages. For example, dependent claims 41, 50, and 59 provide for two particular items – (1) that the subscriber renewal notice is traditionally broadcast via satellite; and (2) broadcast information is transmitted via satellite using the bandwidth that is no longer consumed by the subscriber renewal notices. With respect to (1), there is no indication in Hunter that that Code key C is ever transmitted via satellite or that it is traditionally transmitted via satellite. Further, Hunter also fails to even remotely suggest the use of particular bandwidth for broadcast information.

Dependent claims 42, 51, and 60 also provide that the subscriber renewal notice comprises service provider facility data. In rejecting these claims, the Office Action relies on Hunter paragraphs 79 and 83. These paragraphs of Hunter merely describe the use of particular keys and not service provider facility data. In this regard, the key A is transmitted with a movie and is a monthly code transmitted with the movie, key B is a code for each month chosen by the video distribution system operator and is blanket transmitted via satellite, and key C is a code for each available movie that is sent via phone/modem. Again, the only key transmitted via phone/modem is key C. Further, key C does not contain or refer to any service provider facility data. Instead, it is merely a code for each available movie. Accordingly, Hunter fails to teach various limitations of these dependent claims.

Moreover, the various elements of Applicants' claimed invention together provide operational advantages over Nakano, Hunter, Hayward, and Yamamoto. In addition, Applicants' invention solves problems not recognized by Nakano, Hunter, Hayward, and Yamamoto.

Thus, Applicants submit that independent claims 40, 49, and 58 are allowable over Nakano, Hunter, Hayward, and Yamamoto. Further, dependent claims 41-48, 50-57, and 59-66 are submitted to be allowable over Nakano, Hunter, Hayward, and Yamamoto in the same manner, because they are dependent on independent claims 40, 49, and 58, respectively, and thus contain all the limitations of the independent claims. In addition, dependent claims 41-48, 50-57, and 59-66 recite additional novel elements not shown by Nakano, Hunter, Hayward, and Yamamoto.

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III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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